

REMARKS

I. Status of the Claims

Claims 43-62 and 64-67 are pending in this application. No claim has been amended herein.

II. Rejection under 35 U.S.C. § 112, First Paragraph

Claims 43-62 and 64-67 have been rejected under 35 U.S.C. § 112, first paragraph. The Examiner alleges that the specification “does not reasonably provide enablement for any ‘[a]crylates’ polymer or polymers containing any amount of ethyl acrylate, methyl methacrylate, methacrylic acid and acrylic acid.” Office Action at 2. Moreover, the Examiner alleges that “applicant[] disclose[s] that the invention hinges on the polymer of [European Patent Application No. 0 590 604].” *Id.* Applicant respectfully traverses.

First of all, Applicant’s invention does not “hinge” on the polymer of European Patent Application No. 0 590 604, but rather the polymers described therein are merely exemplary. See the instant specification on page 7, first full paragraph, stating that “[s]uch a copolymer is, **for example**, described in European Patent Application EP-A-590,604, the disclosure of which is hereby incorporated by reference.” (emphasis added).

Moreover, the instant claims are adequately enabled for both an acrylates copolymer or an ethyl acrylate/methyl methacrylate/methacrylic acid/acrylic acid

copolymer. The test for enablement is whether the experimentation needed to practice the invention is undue or unreasonable. M.P.E.P. § 2164.01. In making such a rejection, "specific technical reasons are always required." *Id.* at § 2164.04. Here, the Examiner has failed to establish that this test for enablement cannot be met.

The specification clearly and thoroughly describes the claimed acrylates copolymer and ethyl acrylate/methyl methacrylate/methacrylic acid/acrylic acid copolymer. See, for example, page 4, last paragraph, to page 6, last paragraph, reciting preferred percentages by weight of each of the components of the copolymer; see also the disclosure at page 4, third paragraph to page 7, third paragraph, describing possible acrylates copolymers. Applicant need not identify or exemplify all of the potential copolymers within the scope of the invention, but rather Applicant must only identify a sufficient number of copolymers so that one of ordinary skill in the art can practice the invention without undue experimentation. See M.P.E.P. § 2164.08.

In the instant case, no undue experimentation is necessary in selecting copolymers that are within the scope of the invention, and the Examiner has failed to establish otherwise. This is simply highlighted by the explicit teachings of both the instant specification and European Patent Application No. 0 590 604, incorporated by reference into the instant specification. Applicant therefore respectfully requests reconsideration of the rejection and prompt allowance of the claims.

III. Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 45, 50-53, 57, and 58 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. According to the Examiner, in claims 45, 50, and 57, the term “[a]crylates” is vague; it is not defined in the specification.” Office Action at 2. Applicant respectfully traverses.

Applicant first points out that claims 45, 50-53, 57, and 58 have been rejected. Yet the Examiner only refers “acrylates” as used in claims 45, 50 (upon which claim 51 depends), and 57 (upon which claim 58 depends). The Examiner has failed to explain why it is alleged claims 52 and 53 are indefinite. Therefore, Applicant respectfully requests withdrawal of this rejection as it applies to claims 52 and 53, or clarification on the record.

As regards claims 45, 50, and 57, “acrylates” appears in the claims within the phrase “an acrylates copolymer.” An acrylates copolymer is a term readily understood and used by those of ordinary skill in the art. For example, the International Cosmetic Ingredient Dictionary and Handbook (“CTFA”), 7th Ed., defines acrylates copolymer as “a copolymer of two or more monomers consisting of acrylic acid, methacrylic acid or one of their simple esters.” CTFA at 26 (attached as Exhibit 1). Thus, the term acrylates copolymer, and consequently the scope of the claims, would be clear to one of ordinary skill in the art, and the term is not indefinite. M.P.E.P. § 2173. Applicant therefore respectfully requests reconsideration of the rejection.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 27, 2004

By: Erin C. DeCarlo
Erin C. DeCarlo
Reg. No. 51,688

Attachments: Exhibit 1 - International Cosmetic Ingredient Dictionary and Handbook, Seventh Edition (1997) ("CTFA"), pages 26-27.